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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/310,791	09/29/94	STACHE	02481.1403

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KESTLER, K
EXAMINER

ART UNIT	PAPER NUMBER
1206	3

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED: 02/23/95

- ☒ This application has been examined for restriction/election purposes only ☐ Responsive to communication filed on ____
☐ This action is made final.

A shortened statutory period for response to this action is set to expire 30 days from the date of this letter.
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ _____

Part II SUMMARY OF ACTION

- ☒ Claims 1-6 are pending in the application.
Of the above claims, ____ are withdrawn from consideration.
- ☐ Claims ____ have been cancelled.
- ☐ Claims ____ are allowed.
- ☐ Claims ____ are rejected.
- ☐ Claims ____ are objected to.
- ☒ Claims 1-5 are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on ____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on ____ has been ☐ approved. ☐ disapproved (see explanation).
- ☐ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. ____; filed on ____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

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Restriction/Election Requirement

I. Restriction Requirement.

Restriction to one of the following inventions is required under 35 U.S.C.

121:

Group I. Claims 1-2 and 4, drawn to compounds and compositions, classified in Class 540, subclass 108 and others.

Group II. Claim 3, drawn to a process of making the compounds, classified in Class 552, subclass 569 and others.

Group III. Claim 5, drawn to a method of treating dermatoses, classified in Class 514, subclass 180 and others.

Claim 6 is drawn to a nonstatutory class of invention and, therefore, will not be grouped.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product can be made by a

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different process such as formation of the 17 α -ester from the corresponding alcohol.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product can be used for a different method such as the treatment of arthritis.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

II. Election of Species.

Claims 1-2 and 4-5 are generic to a plurality of disclosed patentably distinct species comprising the species of examples 1-61 and Tables 1-2. If either group I or III is elected, applicant is further required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this

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is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

III. Response.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined and the election of a single disclosed species even though the requirement be traversed.

IV. Amendment of Inventorship.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

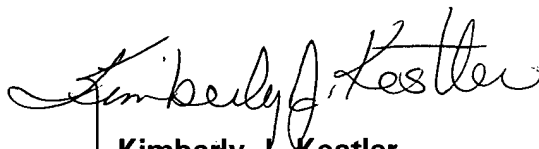
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly J. Kestler whose telephone number is (703) 308-4691. The examiner can normally be reached between 8 and 4. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


Kimberly J. Kestler
PATENT EXAMINER
ART UNIT 1206

KJK
20 February 1995